

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

APPLICANT: John Melvin, et al. TITLE: Mobile Transfilling System
SERIAL NO.: 10/711,787 ART UNIT: 3751
FILING DATE: 10/05/04 EXAMINER: Maust, Timothy Lewis
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Honorable Commissioner for Patents & Trademarks
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APPEAL BRIEF

A Notice of Appeal and appeal fee of \$ 270.00 were previously filed on February 5, 2010 in response to a November 10, 2009 Final Office Action. This Appeal Brief is now being submitted in the above-referenced application, and an appeal brief fee of \$270.00 is being submitted herewith. This Appeal Brief is believed to be timely filed; however, if any extension of time is required, please consider this a request therefor. If any additional fees are due, the Commissioner is authorized and respectfully requested to charge the same to Deposit Account No. 18-2210.

The Examiner's rejections are respectfully traversed, and the Board is respectfully requested to reverse the Examiner's rejections of the applicants' claims for the reasons detailed below.

I. Real Parties in Interest

The real parties in interest are John Melvin and Kenneth Carver II.

II. Related Appeals and Interferences

The current patent application, serial no. 10/711,787, was involved in a prior appeal (Appeal 2009-004276) before the Board. The Board rendered its decision on August 3, 2009. A copy of the Board's decision has been attached in the Related Proceedings Appendix, as Exhibit A.

III. Status of Claims

Claims 1-6 are in the application.

Claims 3-6 have been withdrawn from consideration.

Claims 1-2 are pending and stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mattiola et al. (4,881,375) in view of Niedwiecki et al. (6,755,225). Claims 1-2 are the claims being appealed.

IV. Status of Amendments

No amendments have been filed subsequent to the November 10, 2009 Final Office Action.

V. Summary of the Claimed Subject Matter

In one embodiment, as set forth in independent claim 1, this invention is a method for transfilling gas canisters **101** on-site comprising transporting a transfilling station **100** to a desired transfilling site; attaching gas canisters **101** to said transfilling station **100**; inspecting and evacuating said gas canisters **101**; vaporizing and compressing a gas and directing it into said gas

canisters 101; disconnecting said gas canisters 101; and transporting said transfilling station 100 from said transfilling site. (See specification, pages 5-6, para 34-38; Figure 1)

VI. Grounds of rejection to be reviewed on appeal

Whether claims 1-2 are unpatentable under 35 U.S.C. 103(a) based upon Mattiola et al. (4,881,375) in combination with Niedwiecki et al. (6,755,225), in view of the secondary considerations presented by the applicants.

VII. Arguments

Claims 1-2

Claim Rejection – 35 USC § 103 (a) Obviousness

Background

The examiner rejected claims 1-2 as being unpatentable under 35 U.S.C. 103(a) over Mattiola et al. (4,881,375) in view of Niedwiecki et al. (6,755,225). The Board of Patent Appeals and Interferences issued a decision affirming the examiner's position on August 3, 2009. (Exhibit A to Related Proceedings Appendix). On October 2, 2009, the applicants filed a Request for Continued Examination (RCE), to re-open and continue prosecution in this matter and submitted evidence of secondary considerations for the examiner's review - i.e. Long Felt But Unsatisfied Need in the Prior Art Recognized by Others; Inoperability of the Prior Art; Licensing; Replacement in the Industry of the Prior Art Methods by the Present Invention and Commercial Success. (**Attachments 1-4; Exhibits 1-9**) On October 27, 2009, the applicants submitted a supplemental response, presenting yet additional evidence relating to secondary considerations. (**Attachment 5; Exhibits 10-14C**) On November 10, 2009, the examiner issued a

final office action, confirming his rejection of claims 1-2 as being obvious in view of Mattiola and Niedwiecki.

The basis of this appeal is the examiner's utter failure to take into account the secondary considerations evidencing the invention's patentability. These secondary considerations are reiterated below for the Board's review.

In the current application, there is one independent claim: claim 1 and one dependent claim: claim 2. Independent claim 1 defines a method for transfilling gas canisters on-site including the following limitations:

- a. transporting a transfilling station to a desired transfilling site.
- b. attaching gas canisters to said transfilling station;
- c. inspecting and evacuating said gas canisters;
- d. vaporizing and compressing a gas and directing it into said gas canisters;
- e. disconnecting said gas canisters; and
- f. transporting said transfilling station from said transfilling site.

Independent Claim 2 is as follows: The method of transfilling gas canisters on-site of claim 1 wherein said gas is medical oxygen.

As the examiner has correctly conceded, Mattiola fails to disclose at least one step of applicants' claim 1: transporting a transfilling station to and from a desired transfilling site. However, the examiner found that the combination of Mattiola with Niedwiecki would teach this transportation or mobility step. The applicants note that the Board has previously affirmed the examiner's *prima facie* case of obviousness. While the applicants respectfully disagree with the

Board's position in this regard, the applicants hereby submit numerous secondary considerations as evidence of their invention's patentability. In view of the evidence presented below, the Board is respectfully requested to reverse the Examiner's rejections.

Secondary Considerations

In making a final determination of patentability, evidence supporting patentability must be weighed against evidence supporting a *prima facie* case of obviousness. When an applicant timely submits evidence traversing a rejection, the examiner must *reconsider* the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record. MPEP §716.01 (d). Affidavits or declarations, when timely presented, containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. §103. The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness."

In the present case, the Board is respectfully requested to reconsider the invention's patentability in view of the following secondary considerations that are commensurate with the scope of the claimed invention and which support its patentability.

Long Felt But Unsatisfied Need in the Prior Art Recognized by Others/Inoperability of the Prior Art

Applicants' invention, as defined by claims 1 and 2, relates to a method of oxygen transfilling that is mobile and transportable. Prior to the development of applicants' method, medical equipment supply companies that delivered oxygen tanks/canisters to home patients faced substantial problems with regard to the re-filling of their oxygen canisters. These medical supply companies would have to coordinate and arrange for the transportation of numerous canisters to and from ground-based re-filling stations. These ground-based re-filling stations, in turn, not only took weeks to return the replenished canisters to the medical companies, but were also continually losing their canisters, costing the medical equipment supply companies thousands of dollars in operation and inventory losses. Even more problematically, the ground-based re-filling stations often mistakenly returned canisters to the wrong medical supply equipment company. Furthermore, in times of emergency situations, such as hurricanes, such ground-based re-filling stations often became flooded and/or lost power and thus became inoperable. In such scenarios, medical equipment supply companies, who needed re-filling of their canisters so that they could subsequently deliver them to home patients, were faced with a critical dilemma because they were unable to rely on the ground-based refilling stations.

And although, in the prior art, attempts were undertaken to resolve or alleviate the aforementioned problems, such as medical supply companies purchasing extra inventory, labeling their canisters to prevent loss or misplacement, and in general spending much time and effort to coordinate their operations with the schedules of ground-based re-filling stations, such

attempts were largely unsuccessful. Thus, there existed a long-felt but unsatisfied need in the medical supply equipment industry for an invention that would greatly reduce and/or obviate the above-discussed problems. During this time, the applicants were employed by one such medical equipment supply company that was facing such issues. Recognizing the problems faced by their employer, the applicants realized that the aforementioned problems could be obviated by creating a mobile transfilling station that was capable of being transported to the medical supply companies for an on-site re-filling. Thus, after a period of trial and error and extensive engineering, applicants developed a mobile transfilling station, comprising the necessary transfilling equipment, that met the stringent requirements of both the Food and Drug Administration, as well as the Department of Transportation. The applicants subsequently formed C&M Oxyfill, LLC and began to provide their mobile transfilling services in 2004. The applicants' method began to experience significant success in the regions where it was introduced.

See **Attachment 1** – Declaration of Mr. Barry Blackbird, having over 31 years experience in the industry as a regional manager for a medical supply equipment company that is a current client of two licensees of applicants' that provide the mobile transfilling services. In his declaration, Mr. Blackbird attests to the long-felt but unsatisfied need for the invention, and further delineates how applicants' invention met this need. *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992) (Office personnel should consider declarations from those skilled in the art praising the claimed invention.)

Licensing/Replacement in the Industry of the Prior Art Methods by the Present
Invention/Commercial Success

The applicants' method has currently achieved industry-wide acceptance and commercial success in the southern United States. The applicants have not ever conducted any type or form of advertising. They simply introduced their method into the marketplace several years back, and the advantages of their mobile transfilling method were soon observed and recognized by third parties. In fact, a plethora of third parties approached applicants and obtained licenses to utilize applicants' method. Some of these companies include Purepoint, Inc, Air-eze, LLC, H&C Oxygen, Inc., P& J Oxyfill, LLC, and Quick-Fill Mobile Oxygen Inc. See **Attachment 2**, Declaration of applicant John Melvin, attesting to these third party licensees. (See also **Exhibits 1-8**, referred to by John Melvin in his Declaration.)

These companies in turn have achieved commercial success through their use of applicant's method. In fact, many of the aforementioned licensees have been so successful in their use of the applicants' mobile transfilling method, that they have driven numerous ground-based re-filling station competitors out of business. See **Attachment 3** – Declaration of Tim Ditmore of Quick-Fill Mobile Oxygen Inc., a licensee. (See also **Exhibit 3**, referred to by Tim Ditmore in his Declaration). Mr. Ditmore attests to the long-felt need in the industry, and the replacement in the industry of the prior art methods by the present invention. See also **Attachment 4** – Declaration of James Radcliff of P&J Oxyfill, LLC, a licensee. (See also **Exhibits 1 and 9**, referred to by James Radcliff in his Declaration). Mr. Radcliff attests to how weather conditions rendered ground-based re-filling stations inoperable during Hurricane Katrina

and how the present invention fulfilled the needs of medical supply equipment companies during this time). *In re Tiffin*, 443 F.2d 344, 170 USPQ 88 (CCPA 1971) (fact that affidavit supporting contention of fulfillment of a long-felt need was sworn by a licensee adds to the weight to be accorded the affidavit, as long as there is a bona fide licensing agreement entered into at arm's length).

Copying of the Invention

Pursuant to the MPEP, another form of secondary evidence which may be presented by applicants during prosecution of an application is evidence that competitors in the marketplace are copying the invention instead of using the prior art. MPEP §716.06

On March 13, 2009, a Mr. Kenneth E. Alexander, Vice President of Quality & Regulatory Activities, Louisiana Hospital Association, approached Cryovation LLC, a manufacturer of the applicants' mobile transfilling units. See **Attachment 5** – Declaration of applicant John Melvin and **Exhibit 10** – true and correct copy of email correspondence sent by Kenneth Alexander to Cryovation, LLC.

In his email, Kenneth Alexander indicated that he was with the Louisiana Hospital Association and that he was eager to learn more about the applicants' mobile transfilling method:

I am with the Louisiana Hospital Association and am working with the state of Louisiana on a comprehensive oxygen delivery plan for the state to use during disasters (mostly hurricane season). I would like more information on your products and their capabilities and how it might fit into our statewide plan of supporting evacuation, sheltering, and community oxygen distribution. Please contact me at the above contact info. My request is fairly time sensitive, so prompt response would be most welcome and appreciated.

Many thanks,
Ken Alexander

Exhibit 10

Kenneth Alexander's email simply exemplifies a long-felt but unsatisfied need in the prior art. As discussed previously, one of the problems in the prior art was that in times of emergency situations, such as hurricanes, ground-based re-filling stations often became flooded and/or lost power and thus became inoperable. In such scenarios, medical equipment supply companies, who needed re-filling of their canisters so that they could subsequently deliver them to home patients, were faced with a critical dilemma because they were unable to rely on the ground-based refilling stations. Kenneth Alexander's email evidences that the state of Louisiana realized this dilemma and was reaching out to the applicants' mobile transfilling method as a solution to this prior art problem.

Thereafter, Kenneth Alexander exchanged several other emails with Cryovation via a Mr. Ryan Boyd, who was associated with Cryovation. Ryan Boyd subsequently forwarded Kenneth Alexander's contact information to John Melvin, applicant. **Exhibit 11** are true and correct copies of said emails.

Afterwards, in March and April of 2009, Kenneth Alexander and John Melvin engaged in a series of telephone and email correspondence, whereby John Melvin offered the Louisiana Hospital Association and the State of Louisiana a license to practice his mobile transfilling method. Pursuant to this end, John Melvin explained the design and construction of his mobile transfilling method to Kenneth Alexander, and furthermore provided photographs of the mobile transfilling units. In addition, John Melvin also provided Kenneth Alexander contact information on his current licensees, in the event Kenneth Alexander wanted to correspond with

them or ask them any questions. See **Exhibit 12** – true and correct copy of an email sent by John Melvin to Kenneth Alexander providing the above-discussed information and photographs.

Thereafter, on April 16, 2009, John Melvin sent an email to Kenneth Alexander, inquiring whether he had any remaining questions or if there was anything he could do on his part to further illuminate how the mobile process worked. Kenneth Alexander responded, indicating he was still interested in applicants' method, yet hadn't had the opportunity to discuss the issues on his end. After this point, John Melvin did not hear from Kenneth Alexander again.

See **Exhibit 13** – true and correct copy of said emails.

Subsequently, in October of 2009, John Melvin discovered that the Parish of Ascension, as well as the state of Louisiana, had adopted a mobile transfilling procedure as claimed in independent claim 1. See, **Exhibit 14A**, **Exhibit 14B** and **Exhibit 14C** – true and correct copies of three website articles evidencing the same:

During times of emergency, such as after a hurricane or major power outage, the mobile oxygen unit will be deployed to a pre-determined location with Ascension Parish. Residents will bring their own personal oxygen tanks...and have their tanks refilled at no charge.

Exhibit 14A – website article

“This system is a godsend,” said Dr. Bernard Brach of St. Elizabeth’s Hospital. “It represents a unit that will take the pressure off physicians when it comes to patients’ needs.”

Exhibit 14C – website article.

Thus, evidence of copying by the Parish of Ascension, as well as the State of Louisiana, is a significant secondary consideration that the Board should take into account, along with the other secondary considerations, as evidence of the non-obviousness of the mobile transfilling

method.

In the November 10, 2009 Office Action, the examiner essentially disregards the above-discussed evidence of secondary considerations, providing no analysis, deliberation or discussion of the same. Instead, the examiner merely imparts a one-sentence conclusory remark that “the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.” (See page 2 of November 10, 2009 Office Action)

The examiner does however offer the following baffling statement, presumably to justify his decision: “Even though there is a showing that others of ordinary skill in the art were working on the problem, *there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem.*” As support for his statement, the examiner cites to MPEP §716.04. However, MPEP §716.04 sets forth *absolutely no requirement* that persons skilled in the art who are working on the problem have knowledge of the teachings of the prior art references. MPEP §716.04 only requires that the claimed invention must satisfy a long-felt need which was recognized and not solved by others. As shown above, the applicants have already established this requirement.

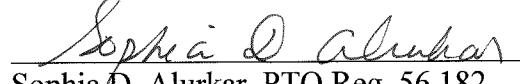
Conclusion

In view of the above-discussed considerations evidencing the non-obviousness of the applicants’ invention, the Board is respectfully requested to re-consider the patentability of the claimed invention. For all the aforementioned reasons, the examiner’s rejections of claims 1-2

are not well founded and the Board is therefore respectfully requested to reverse the examiner's rejection of these claims.

Respectfully submitted:

Date: 2/9/10


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VIII. Claims Appendix

CLAIMS PRESENTED ON APPEAL

Claim 1 A method for transfilling gas canisters on-site comprising:
transporting a transfilling station to a desired transfilling site;
attaching gas canisters to said transfilling station;
inspecting and evacuating said gas canisters;
vaporizing and compressing a gas and directing it into said gas canisters;
disconnecting said gas canisters; and
transporting said transfilling station from said transfilling site.

Claim 2 The method of transfilling gas canisters on-site of claim 1 wherein said gas is medical oxygen.

IX. Evidence Appendix

Attachment 1 – Declaration of Mr. Barry Blackbird. (Entered in record as Attachment 1 to October 2, 2009 RCE submission).

Attachment 2, Declaration of applicant John Melvin. (Entered in record as Attachment 2 to October 2, 2009 RCE submission).

Attachment 3, Declaration of Tim Ditmore. (Entered in record as Attachment 3 to October 2, 2009 RCE submission).

Attachment 4, Declaration of James Radcliff. (Entered in record as Attachment 4 to October 2, 2009 RCE submission)

Exhibits to Attachments 1-4

Exhibit 1 Licensing Agreement between C&M Oxyfill and P& J Oxyfill. (Entered in record as Exhibit 1 to October 2, 2009 RCE submission)

Exhibit 2 Licensing Agreement between C&M Oxyfill and Air-eze.(Entered in record as Exhibit 2 to October 2, 2009 RCE submission)

Exhibit 3 Licensing Agreement between C&M Oxyfill and Quick Fill (Entered in record as Exhibit 3 to October 2, 2009 RCE submission)

Exhibit 4 Licensing Agreement between C&M Oxyfill and Purepoint (Entered in record as Exhibit 4 to October 2, 2009 RCE submission)

Exhibit 5 Licensing Agreement between C&M Oxyfill and H&C Oxygen (Entered in record as Exhibit 5 to October 2, 2009 RCE submission)

Exhibit 6 Air-eze Customer List (Entered in record as Exhibit 6 to October 2, 2009 RCE submission)

Exhibit 7 Purepoint Customer List (Entered in record as Exhibit 7 to October 2, 2009 RCE submission)

Exhibit 8 H&C Oxygen Customer List (Entered in record as Exhibit 8 to October 2, 2009 RCE submission)

Exhibit 9 P& J Oxyfill Customer List (Entered in record as Exhibit 8 to October 2, 2009 RCE submission)

Attachment 5 Declaration of John Melvin. (Entered in record as Attachment 5 to October 27, 2009 Supplementary Amendment)

Exhibits to Attachment 5

Exhibit 10 Email correspondence by Kenneth Alexander to Cryovation. (Entered in record as Exhibit 10 to October 27, 2009 Supplementary Amendment).

Exhibit 11 Email correspondence between Kenneth Alexander and Ryan Boyd. (Entered in record as Exhibit 11 to October 27, 2009 Supplementary Amendment).

Exhibit 12 Email correspondence and photographs sent by John Melvin to Kenneth Alexander (Entered in record as Exhibit 12 to October 27, 2009 Supplementary Amendment).

Exhibit 13 Email correspondence between John Melvin and Kenneth Alexander (Entered in record as Exhibit 13 to October 27, 2009 Supplementary Amendment).

Exhibit 14A Website Article (Entered in record as Exhibit 14A to October 27, 2009 Supplementary Amendment).

Exhibit 14B Website Article (Entered in record as Exhibit 14B to October 27, 2009 Supplementary Amendment).

Exhibit 14C Website Article (Entered in record as Exhibit 14C to October 27, 2009 Supplementary Amendment).